

Appl. No. 10/817,097  
Amdt. dated October 29, 2005  
Reply to Office action of September 12 2005

**REMARKS/ARGUMENTS**

Claims 1, 3 to 18, and 20 are in the application.

Claims 1 and 18 stand rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admitted prior art (hereafter PRIOR) in view of United States 3,422,721 to Yonkers (hereafter Yonkers). Claims 3 to 18 and 20 stand rejected under 35 U.S.C. 112. Appropriate amendments have been made to overcome the rejections under 35 U.S.C. 112. The rejection under 35 U.S.C. 103 is respectfully traversed.

**RESPONSE TO 35 U.S.C 103 REJECTIONS**

Claims 1 stands rejected under 35 U.S.C. 103(a) as being unpatentable over PRIOR in view of Yonkers. Not only are these references improperly combined, even if they are in assumed combinable for the sake of argument, Applicant's invention still is not taught.

There is no teaching to combine Yonkers with the prior art teachings of applicant. Yonkers teaches putting the material on corrugated metal. Applicant's surface is a remotely controlled toy vehicle. Such vehicles lack the stability of the Yonkers surface and require great effort to achieve applicant's desired results. Those vehicles contemplated by applicant have a relatively delicate surface compared to the Yonkers surface. Thus, there is no teaching to combine the two references.

Even if the references are assumed combinable for the sake of argument, applicant's invention still is not taught. The structure taught by Yonkers would clearly cause damage to the surface of the remotely controlled toy vehicles, on which applicant contemplates using his invention. Thus without more, this combination of references cannot render the claimed invention obvious.

Applicant's advantages are clearly disclosed, plainly discussed and heavily emphasized in applicant's claims and specification. These factors bring this application into the

Appl. No. 10/817,097

Amdt. dated October 29, 2005

Reply to Office action of September 12 2005

realm of U. S. v. Adams, 383 U.S. 39, 48-49; 148 USPQ 479, 482 (1966), which includes the following interpretation of the patent law:

"Novelty and nonobviousness, as well as utility, are separate tests of patentability. All must be satisfied in a valid patent.

"While patent claims limit invention, and specification cannot be utilized to expand patent monopoly, claims are construed in light of specification and both are read with a view to ascertaining the invention."

#### **RESPONSE TO 35 U.S.C 112 REJECTIONS**

Claims 3 - 12, and 14-17 stand rejected under 35 U.S.C. 112. Appropriate amendments to the claims and specification within the scope of Paragraphs 6, 7 and of the office section have been made, as suggested by the Examiner. As such, the appropriate language has been inserted.

#### **CONCLUSION**

Accordingly, all rejections having been overcome by amendment or traversed by remarks, reconsideration and allowance of the instant application is respectfully requested. Applicant's attorney remains amenable to assisting the Examiner in the allowance of this application.

Applicant respectfully requests that a timely notice be issued in this case.

Respectfully submitted,

By: 

Mathew R. P. Perrone, Jr.

Reg. No. 22,951

Tel: (847) 658-5140

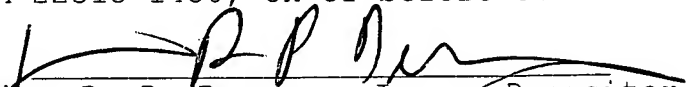
I hereby certify that this correspondence is being deposited by facsimile to (571)273-8300 addressed to: Mail Stop Non-Fee Amendment, Commissioner for Patents, P.O. Box 1450,

Appl. No. 10/817,097

Amdt. dated October 29, 2005

Reply to Office action of September 12 2005

Alexandria, VA 22313-1450, on or before October 31, 2005.

  
Mathew R. P. Perrone, Jr. -- Depositor

Mathew R. P. Perrone, Jr.

Attorney for Applicant

210 South Main Street

Algonquin, Illinois 60102

Telephone Number 847-658-5140

Registration Number 22,951

Date of faxing on or before October 31, 2005.

Appl. No. 10/817,097  
Amdt. dated October 29, 2005  
Reply to Office action of September 12 2005

**Amendments to Drawings:**

In view of the Examiner's comments in Paragraphs one, two, and three of the office action, new and formal drawings are submitted herewith. In this manner, no further comments are needed on those points.

NEW DECLARATION

A new declarations submitted herewith as required by the Examiner.

FEE STATEMENT

No additional fee is due because the number and type of newly added claims are the same as the number and type of originally presented, but now cancelled claims. Nevertheless, an appropriate authorization to charge or credit the deposit account of applicant's attorney is enclosed in the required duplicate original form -- to be used if necessary.